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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,257	01/22/2002	Frederick R. Bean	TN-2239	3692
7590 12/19/2005			EXAMINER	
Adan Ayala, Esq. Black & Decker Inc. 701 E. Joppa Road, TW-199 Towson, MD 21286			NGUYEN, PHONG H	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/054,257	Applicant(s) BEAN ET AL.	
	Examiner Phong H. Nguyen	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the pre-Appeal brief filed on 11/14/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

Specification

2. The Specification is objected to under 37 CFR 1.71 because it is unclear how the sliding fence 22 can slide on the surface of the fixed fence 21. The structure of the fixed fence 21 is for mounting or removing the sliding fence 22 but not for facilitating sliding movement of the sliding fence.

Appropriate correction is required.

Drawings

3. The drawings are objected to as failing to comply 37 CFR 1.81 because they do not facilitate better understanding of the subject matter sought to be patented.

It is unclear what the dash lines and the horizontal solid line on the left side of the Fig. 2 in the area designated as 11C represent for. It is unclear what the bottom surface of the table looks like so that it can accommodate the wearing ring. A perspective drawing of Fig. 2 is needed for better understand the invention.

It is unclear whether Figs. 14 and 15 are the front view of Fig. 1 since in Fig. 1 the hole FFH is on the top of the fixed fence 21 but not in the front surface as shown in Figs.

14 and 15 and there is no hole FFH on the fence 25. Fence 25 in Fig. 1 has a U-shape but not a rectangular shape as shown in Fig. 14 and 15.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "21" and "22" have both been used to designate the same fence in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sliding fence and the stop fixture in claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 9, it is unclear how the slidable fence can slide on the top surface of the fixed fence.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it appears that claim 1 states some portions of the wearing ring being not moveable which is not correct.

Regarding claim 9, it does not seem the sliding fence slidable with respect to the fixed fence. It appears that the sliding fence is removable with respect to the fixed fence but not slidable.

Regarding claim 10, it is unclear whether 3/16 inches is the unit of the hole's diameter or the hole's depth.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Chang (5,855,366).

It is to be noted that since the fence assembly 20 is called both a fixed fence and a sliding fence and there is no other description of the fixed fence and the sliding fence in

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the Specification, the Examiner calls the fence assembly 20 in Chang both a fixed fence and a sliding as the Applicant does so.

Chang teaches a miter saw comprising a base assembly, a turntable, a saw assembly, a fixed fence 22, a sliding fence 22 and a hole 215 for fixing an end stop fixture. See Figs. 1 and 2.

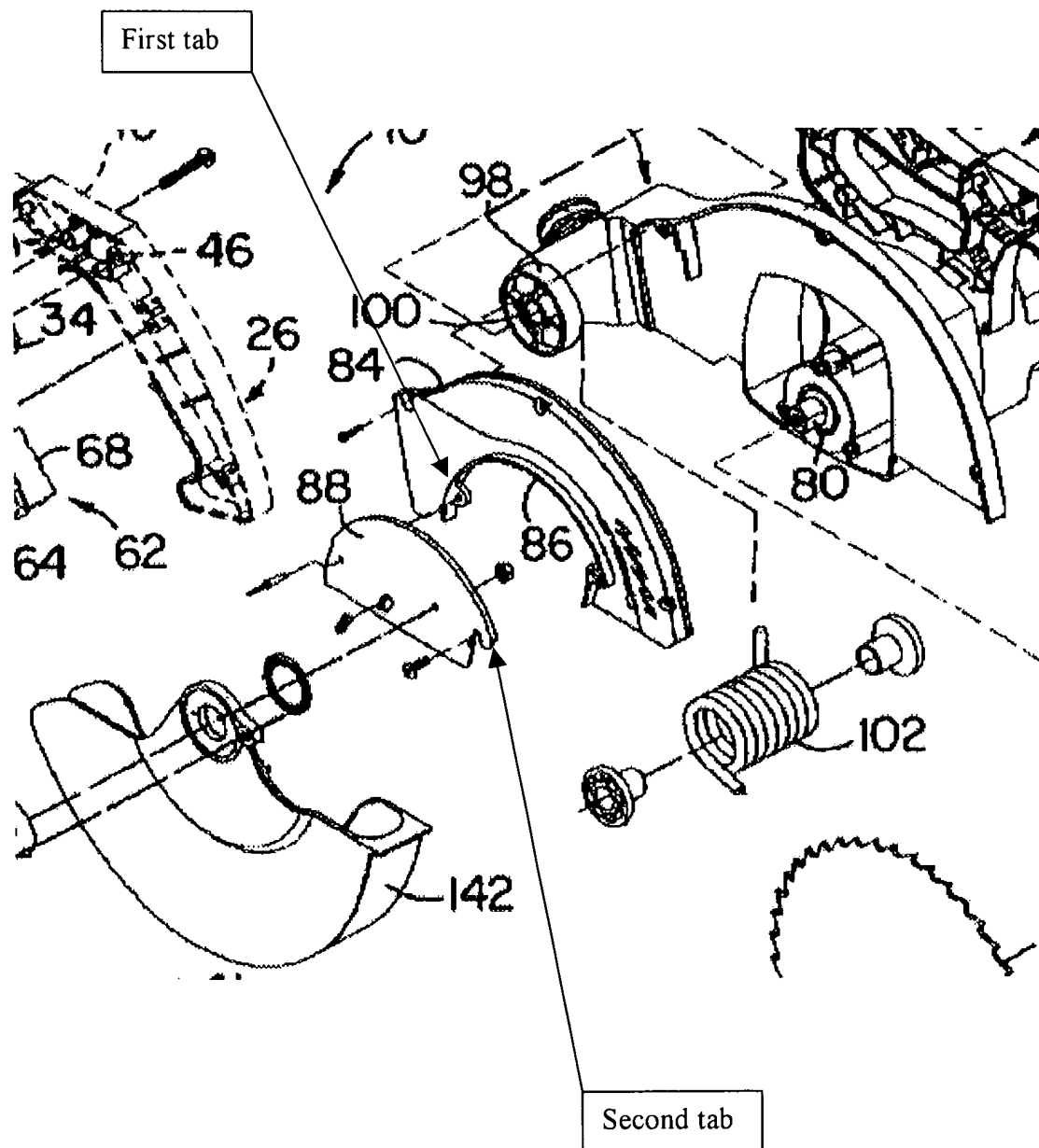
12. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (5,778,747).

Regarding claim 13, Chen teaches a chop saw assembly comprising a base assembly and a saw assembly. The saw assembly comprises an upper blade guard 84, a plate 88 and a lower blade guard 142. A screw secures the plate 88 to the upper blade guard 84.

A first tab on the upper blade guard 84 extends outwardly near the screw. The thickness of the first tab is the first distance. It is inherently to unscrew the screw a distance longer than the first distance to pivot the plate 88. See Figs. 1 and 3.

Regarding claims 14-16, a second tab on the plate is best seen in Fig. 3.

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Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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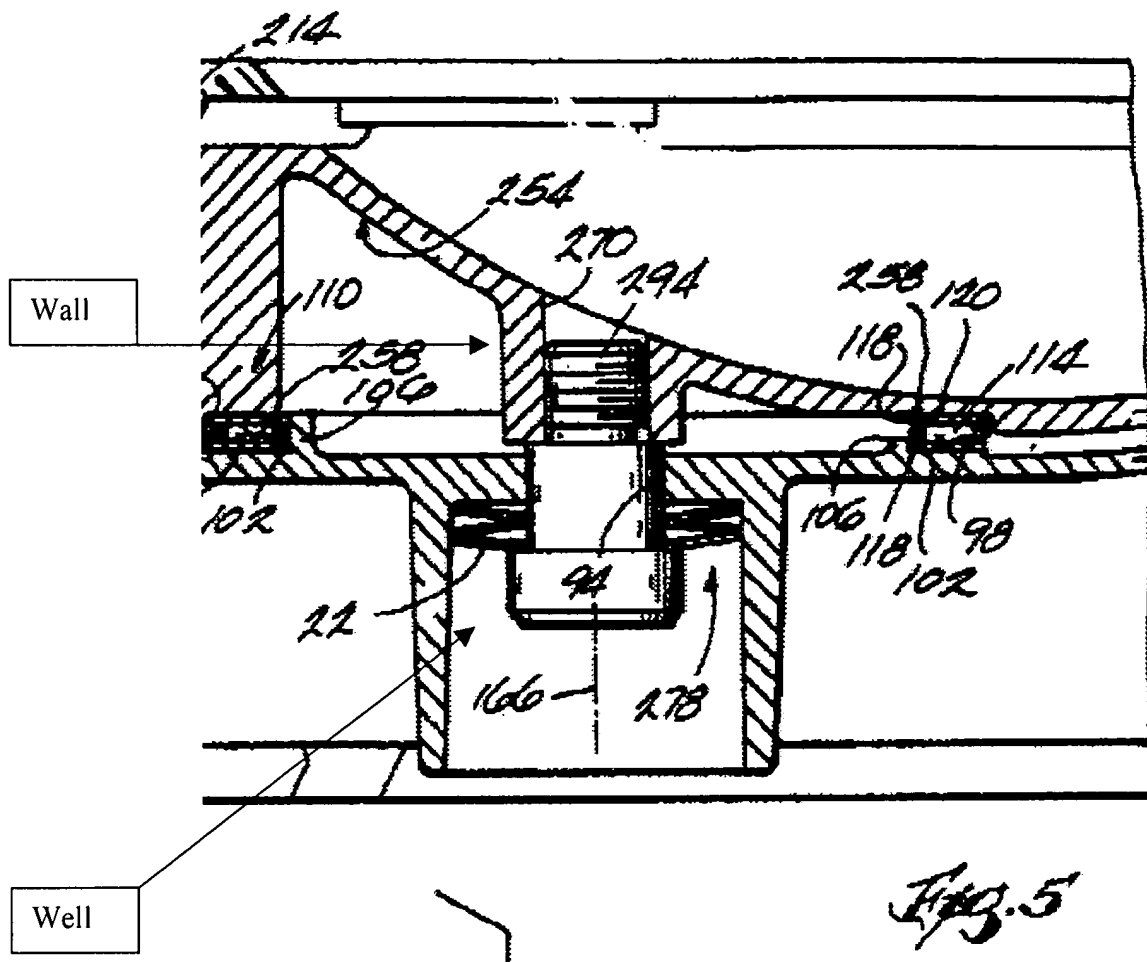
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault et al. (6,431,042 B1), hereinafter Brault, in view of Littley et al. (4,226,151), hereinafter Littley.

Regarding claims 1-3, Brault teaches a miter saw comprising a base 14, a table 182 rotatably attached to the base 14 and a saw assembly 150. See Figs. 1 and 5-7.

Brault fails to teach a wearing ring. Brault teaches using a threaded bolt and washers to connect the base and the table together. Littley teaches a wearing ring 86 being used in a combination with a pin 89 for connecting two parts together. See Fig. 8. Therefore, it would have been obvious to one skilled in the art to replace the threaded bolt and the washers of the Brault's miter saw with the pin and the wearing of Littley since the structure of Littley has less parts and easier to manufacture.

Regarding claims 4-7, a well and a wall are 270 are best seen in Fig. 5 in Brault.



15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (5,855,366).

Chang does not teach the size of the hole 215. However, providing an appropriate size for a hole is routine skill in the art. Therefore, it would have been obvious to one skilled in the art to make the hole in Chang 3/16 inches since such practice is routine skill in the art.

Response to Arguments

16. Applicant's arguments filed on 11/14/2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-7, 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's argument with respect to Chen is not persuasive. The distance between the lower blade guard and the upper blade guard is zero since they are in contact; thus, any moving distance of the screw due to unscrewing would be greater than zero. Chen meets the claim language.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: *pn*

December 6, 2005



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